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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/866,541	05/29/2001	Tsunekazu Ishihara	3917-4	4238

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EXAMINER

COBURN, CORBETT B

ART UNIT	PAPER NUMBER
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3714

DATE MAILED: 09/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/866,541

Applicant(s)

ISHIHARA ET AL.

Examiner

Corbett B. Coburn

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 August 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,7-16,18-46,48,49 and 51-72 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,7-16,18-46,48,49 and 51-72 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>6/15/05, 8/3/05, 11/1/05</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement filed 15 June 2005 and (again) on 3 August 2005 fail to comply with 37 CFR 1.97(d) because they lack a statement as specified in 37 CFR 1.97(e). They have been placed in the application file, but the information referred to therein has not been considered.
2. The information disclosure statement filed 15 June 2005 and (again) on 3 August 2005 fail to comply with 37 CFR 1.98(a)(3) because they do not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each document listed that is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered.

Allowable Subject Matter

3. The indicated allowability of claims 1, 7-16, 18-43, 51-57, 61 & 62 is withdrawn in view of the newly discovered reference(s) to Kaneko (US patent Number 5,331,141) and Bromley (US Patent Number 5,026,058). Rejections based on the newly cited reference(s) follow.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. Claim 1, 9, 13, 15, 21, 25-32, 35, 39-46, 48, 52-54, 63, 65 & 68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaneko (US patent Number 5,331,141) in view of Bromley (US Patent Number 5,026,058).

Claims 1, 13, 25, 28, 29, 31, 32, 39, 40, 44, 45, 48, 54, 63, 65: Kaneko teaches a game system having a plurality of cards (4). The cards include recorded data (Col 15, 13-16) for use in a card game. There is a game information storage medium (8) storing a game program relating to game card figures in RAM and ROM. The game information storage medium (8) is readily removable from the processing system and contains processing circuitry (memory). (Fig 13) There is a processing system (5) for receiving therein the game information storage medium. The game machine executes an image display game program that is stored in the memory section. (Col 13, 47 - Col 14, 3) The cards store, for each character depicted, identification data and characteristic data relating to a characteristic of an associated character (Col 15, 13-16) and for causing a change to a graphics image involving a displayed associated character dependent on the progress of the image-displaying game. (Col 13, 47 - Col 14, 3) The card contains data concerning the strength of the character and any skills or defenses. The data is read by the processor and used to determine success and failure of attempted attacks and defenses. The game determines the success of the batting (i.e., attacking) team and the fielding (i.e., defending) team based on the player statistics read from the cards. (Fig 16) The game system has a game piece reader (10) for reading the identification and characteristic data from the card. The processing system processes the supplied identification and characteristic data from one or more game cards (a first and second card) in accordance

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with the game program stored in a second game program memory section. (Fig 16)

There is a connector connecting the card reader to the game machine having a processing system for executing a game program. (Fig 13)

Kaneko fails to teach that the cards visually portray a figure. This is extremely well known to the art. Bromley teaches a similar game that includes a card (88) that visually portrays a figure (Fig 9A) as well as text explaining the character (i.e., player stats, Fig 9B). Baseball cards have traditionally portrayed an image of the player. This adds interest to collecting the cards. It would have been obvious to have modified Kaneko in view of Bromley to have the cards visually portray a figure in order to add interest to collecting the cards.

Kaneko teaches that the characters are displayed during the course of game play. (Col 13, 47 - Col 14, 3) While this almost certainly suggests animation of the images and causing a change in the video image involving an animated and displayed associated character dependent on the progress of the game, this is not explicitly disclosed. Bromley teaches animation of the images and causing a change in the video image involving an animated and displayed associated character dependent on the progress of the game – the movement of the ball and players on the field is depicted throughout the course of the game. (Fig 7) Animation is the essence of the video game. Animation adds interest to a video game. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Kaneko in view of Bromley to cause a change in the video image involving an animated and displayed associated character dependent on the progress of the game in order to add interest to the game.

Claims 9, 35: Bromley teaches including text on the card explaining an individual feature of the character. (Fig 9B) Kaneko teaches displaying text read from the card on the screen. (Col 13, 53-58)

Claim 15: Kaneko teaches that the characteristic data includes ability data related to the character and the processing system generates a display state of the character in the game based on the ability data read by the external information reading circuit. The character's position on the screen is based on ability data. For instance, a character's ability to be a pitcher would cause him to be displayed on the pitcher's mound. A character's ability to bat left-handed would cause the player to be displayed on the appropriate side of the plate during batting.

Claims 26, 41, 43, 52 & 68: Kaneko teaches a groove (11) for receiving at least a portion of the card and reading the card. Kaneko teaches that both the barcode reader (11) and game cartridge (8) are removable. (Col 17, 35-40) But Kaneko does not teach putting the groove and card reader on the removable memory cartridge. The reader and the cartridge are electrically connected and the game will not function unless both are present. Combining the two devices in a single housing would free up a communications port and would ensure that the two devices stayed together – thus preventing the system from becoming unusable because one or the other component was lost. This would greatly enhance user convenience. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Kaneko to put the groove and card reader on the removable memory cartridge in order to enhance user convenience.

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Claim 27: Kaneko and Bromley both teach cards that store a plurality of kinds of characteristic data (i.e., power, offensive & defensive data) on an identification-code -by-identification-code basis – i.e., each is recorded on a barcode. Bromley has a computer (Fig 11) with semiconductor solid-state memory for storing characteristic data. The computer is in a case (Fig 1) and is integrally formed with the card reader.

Claims 30, 46, 53: Bromley shows a hand-held device including a display.

Claim 42: Kaneko teaches a game machine that executes an image display game program that is stored in one memory section. The cards store, for each character depicted, identification data and characteristic data relating to a characteristic of an associated character. The game system has a game piece reader (11) for reading the identification and characteristic data from the card. The processing system processes the supplied identification and characteristic data in accordance with the game program stored in a second game program memory section. (Fig 13)

6. Claims 8, 10, 14, 34, 36, 51, 56, 57, 64, 66, 69 & 72 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaneko and Bromley as applied to claim 1, 13, 28 or 51 in view of Yokoyama.

Claims 8, 14, 20, 34, 56: Kaneko and Bromley teach the invention substantially as claimed, but do not teach providing appropriate sound data via barcodes and generating sounds based on this data. Sounds are an integral part of video games. They add excitement to the game. Yokoyama teaches providing appropriate sound data via barcodes and generating sounds based on this data. (Fig 25) It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Kaneko

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and Bromley in view of Yokoyama to provide appropriate sound data via barcodes and generate sounds based on this data in order to add excitement to the game.

Claims 10, 22, 36, 51, 64, 66: Both Kaneko and Bromley teach a card reader that is an optical reader for optically reading the identification and characteristic data corresponding to the character visually depicted on the card. They fail to teach that the barcode is a two-dimensional array of dots. Yokoyama teaches a game card that records the identification and characteristic data may be in the form of a two-dimensional array of dots. (Fig 30) A two-dimensional array of dots is a well-known equivalent to a barcode.

Claim 57: Kaneko and Bromley teach the invention substantially as claimed, but do not teach that the processing system, when not supplied with the identification data and characteristic data by the card reader (11) executes a process on the basis of only the game program stored in memory. Yokoyama teaches that the processing system, when not supplied with the identification data and characteristic data by the card reader executes a process on the basis of only the game program stored in memory. This allows the implementation of a one-player mode. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Kaneko and Bromley in view of Yokoyama to have the processing system, when not supplied with the identification data and characteristic data by the card reader execute a process on the basis of only the game program stored in memory in order to implement a one-player mode.

Claim 69, 72: Yokoyama teaches determining whether a sufficient number of cards have been read to execute the game. (I.e., in one player or two player modes.) In order to make this determination, the game must base the execution of the game on total amount

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data. This data is derived from information read from the cards – i.e., the number and type of cards read.

7. Claims, 11, 12, 16, 19-24, 37, 38, 60, 67, 70 & 71 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaneko and Bromley as applied to claim 1 or 28 and further in view of Eskildsen (US Patent Number 5,962,839).

Claims 11, 12, 16, 23, 24, 37 & 38: Kaneko and Bromley teach the invention substantially as claimed, but do not teach a magnetic card. Eskildsen teaches that the card data may be recorded on non-volatile memory and read therefrom via a magnetic reader. (Col 1, 46-48) In this embodiment, the characteristic data includes ability data recognizably printed on the game card (see Bromley, Figs 9A & B) and hidden data not visibly printed on the game card. The picture with identifying information is recognizably printed on the game card while the data stored on the magnetic medium is not visibly printed. It is well known that magnetic cards and barcodes are equivalent. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Kaneko and Bromley in view of Eskildsen to make use of a magnetic card in order to achieve an equivalent function with an equivalent structure.

Claims 18, 60: Eskildsen teaches storing additional data that includes a mini-game program that may be added to the game based on the game program stored in the game information medium. Each of Eskildsen's barcode represents a mini-game program.

Claims 19, 20: Eskildsen teaches including sound data on the bar codes.

Claim 21: Both Kaneko and Bromley teach an identification code (barcode) on the card. Bromley's card identifies the visually portrayed character. The data stored on the card is, in and of itself, "data for determining the amount of data recorded".

Claim 22: Both Kaneko and Bromley teach a card reader that is an optical reader for optically reading the identification and characteristic data corresponding to the character visually depicted on the card. They fail to teach that the barcode is a two-dimensional array of dots. A two-dimensional array of dots is a well-known equivalent to a barcode.

Claim 67: Kaneko and Bromley teach the invention substantially as claimed, but do not teach that the recoded data (i.e., the barcode) embodies program instructions that are executed by the processing system. Kaneko teaches that any game may be implemented with the disclosed system. (Col 14, 60-63) Eskildsen teaches a game in which the recoded data (i.e., the barcode) embodies program instructions that are executed by the processing system. This greatly increases the flexibility of the game because it allows players to determine the order in which to execute commands. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Kaneko and Bromley in view of Eskildsen to have the recoded data (i.e., the barcode) embody program instructions that are executed by the processing system in order to increase the flexibility of the system by allowing players to determine the order in which to execute commands.

Claims 70, 71: Eskildsen teaches that the barcodes may be read in any order desired by the player. Thus the order may be rearranged.

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8. Claims 7, 33, 49 & 55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaneko and Bromley as applied to claim 1, 25, 28, 44 or 54 above, and further in view of Garfield (US Patent Number 5,662,332).

Claims 7, 33, 49, 55: Kaneko and Bromley teach a game machine using cards to play a game associated with a game program. Bromley teaches that the game cards baseball cards. (Col 5, 6-16) Baseball cards are collecting cards, but Bromley does not explicitly teach a trading card game with characters of differing rarity values. Garfield teaches a trading card game including a figure of a character differing in rarity value. (Col 7, 56-58) Garfield teaches having cards of differing rarity values increases the value of the game components (rare cards) and encourages players to trade and collect game cards. (Col 7, 12-20) It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Bromley's card game by including trading cards of differing in rarity value as suggested by Garfield in order to increase the value of the game components (rare cards) and encourages players to trade and collect game cards.

9. Claims 61 & 62 rejected under 35 U.S.C. 103(a) as being unpatentable over Kaneko and Bromley in view of Yamada (US Patent Number 6,398,651).

Claim 61: As discussed in detail above, Kaneko and Bromley teach the invention substantially as claimed, but do not teach the game card being machine-readably recorded with image data for displaying the image of a character on the display screen. It is well within the capability of Kaneko to store such data. In fact, Kaneko discloses use of such data, but does not discuss how it is loaded into the machine. (Col 13, 47-57) Yamada teaches storing such information on cards and displaying the image data read from the

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card on the screen. This provides a convenient method of supplying the data required by Kaneko's disclosure. It would have been obvious to one of ordinary skill in the art at the time of the invention to have machine-readably stored image information on cards and displaying the image data read from the card on the screen in order to supply the data required to implement Kaneko's disclosure.

Claim 62: Kaneko teaches a game card that records the identification and characteristic data as a barcode. A barcode is the equivalent of an array of dots distributed within blocks.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Reference Name	Reference Number	Applicability
Hara	EP 0567687	Barcode game
Seigel et al.	US 2003/0134679	Barcode game

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Corbett B. Coburn whose telephone number is (571) 272-4447.

The examiner can normally be reached on 8-5:30, Monday-Friday, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jessica Harrison can be reached on (571) 272-4449. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Corbett B. Coburn". The signature is fluid and cursive, with the first name "Corbett" being more prominent than the last name "Coburn".

Corbett B. Coburn
Examiner
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